

Appl. No. 10/757,629
Atty. Docker No. 8194C
Response Dated January 31, 2007
In response to Office Action of October 31, 2006
Customer No. 27752

REMARKS

Claim Status

Claims 1, 4, 5, and 8-19 are pending. Claims 1, 4, 5, and 8-19 stand rejected under 35 USC § 103. With this response, no claims are withdrawn, canceled, amended, or added.

Rejections Under 35 USC § 103(a) Over Schmidt in view of Vukos and Tritsch

Claims 1, 4, 5, 8-10 and 11-19 stand rejected under 35 USC § 103(a) as being unpatentable over Schmidt (US 3,797,495) in view of Vukos, et al. (US D422,078) and further in view of Tritsch (US 3,937,221). The Applicant does not admit that any characterization by the Office Action regarding these rejections is correct, but discusses such characterizations herein for the sake of argument. The Applicant traverses the rejections of the pending claims under 35 USC § 103 over the Vukos and Tritsch references for the reasons discussed below.

Independent claims 1 and 17, as previously presented, each recite in part "a surface fastening system" including a "first surface fastening element further including an effective dimension Y extending substantially parallel to a longitudinal axis of the article, the effective dimension Y increasing from a distal edge of the first fastening element to a proximal edge of the first fastening element."

MPEP § 2112 (IV) states:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

The Applicant submits that the ear of the Vukos reference does not necessarily include a "first surface fastening element" as recited in part in the Applicant's independent claims 1 and 17. From the Applicant's review, Figure 1 of the Vukos

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reference appears to illustrate an ornamental design for a disposable absorbent article that includes ears. The Office Action appears to take the position that, in the Vukos reference, the end of the ear is a surface fastening element. (Page 2, point 2.) However, the Vukos reference does not appear to describe, teach, or suggest that any particular element illustrated therein is a surface fastening element. Thus, the Vukos reference does not necessarily include a "surface fastening element."

Even if the Vukos reference does suggest the presence of a surface fastening element, the Vukos reference does not describe, teach, or suggest, "an effective dimension Y" of the surface fastening element, as recited in part in the Applicant's independent claims 1 and 17. The Office Action appears to take the position that, in the Vukos reference, the end of the ear forms the surface fastening element, so the surface fastening element includes an effective dimension Y. (Figure 1, page 4.) However, the Applicant's specification states that "a fastening element covers or forms at least a portion of the surface of one material and joins that surface to at least a portion of a surface of another material." (Page 13, lines 20-22.) If the ear of the Vukos reference does include a surface fastening element, the surface fastening element might cover only a portion of an inside surface of the ear, which would be hidden from view in the figures of the Vukos reference. This portion might not include an effective dimension Y as recited in part in the Applicant's independent claims 1 and 17. Thus, the Vukos reference does not necessarily include a surface fastening element with an "effective dimension Y."

From the Applicant's review, neither the Schmidt reference nor the Tritsch reference appear to cure the deficiencies of the Vukos reference. Thus, the Schmidt Vukos, and Tritsch references, either independently or in combination, do not describe, teach, or suggest a "first surface fastening element further including an effective dimension Y extending substantially parallel to a longitudinal axis of the article, the effective dimension Y increasing from a distal edge of the first fastening element to a proximal edge of the first fastening element" as recited in part in the Applicant's independent claims 1 and 17. As a result, the Applicant respectfully requests reconsideration and withdrawal of the 103(a) rejections for independent claims 1 and 17 and for the pending claims which depend therefrom.

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Conclusion

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the cited references. Accordingly, the Applicant respectfully requests reconsideration of this application and allowance of the pending claims.

Respectfully submitted,

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By Charles R. Ware

Signature

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Date: January 31, 2007
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